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In the Supreme Court of the United States

OCTOBER TERM, 1943.

No. 169.

THE I. T. S. COMPANY,
Petitioner,

vs.

SEIBERLING RUBBER COMPANY,
and
THE SEIBERLING RUBBER COMPANY,
Respondents.

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI.

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The Sixth Circuit Court of Appeals in denial of the Motion for New Trial (Record page 511) concurred with the District Court's ruling (Record page 57) in excluding, at the instance of respondents, evidence as to the alleged difficulties involved in the method or process by which such heels are manufactured, which evidence was excluded on the well-established rule that a patentee is estopped by proceedings in the Patent Office from recapturing a position once relinquished. There is no diversity of opinion in this case or in the Federal Courts on the "File Wrapper Estoppel," and this question is immaterial to the present petition.

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It is immaterial that there is diversity of decision between the various courts of appeals concerning the character of the test of invention used or of the standard of invention which this Court has established, because, upon the objective test asserted in behalf of petitioner as the correct one (Petitioner's Brief, page 20), the Sixth Circuit Court of Appeals found against petitioner.

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I.

THE OPINIONS OF THE COURTS BELOW.

The opinion of the District Court is reported in 53 U. S. P. Q. 627, and is reproduced at pages 431 to 438 of the Record.

The opinion of the Sixth Circuit Court of Appeals is reported in 134 F. (2d) 871, and is reproduced at pages 484 to 490 of the Record.

II.

JURISDICTION.

Jurisdiction of this Court to implement the recommendation of the National Patent Planning Commission that the question of invention in patent cases "be determined objectively by the nature of the contribution to the advancement of the art" is not questioned, but jurisdiction of this Court in the present case is denied on the

ground that the Sixth Circuit Court of Appeals in this case decided the question of invention "objectively by the nature of the contribution to the advancement of the art," and hence, there is no issue upon which to review the opinion below. (See: *White v. Johnson,* 282 U. S. 367, 373; *United States v. Hall,* 313 U. S. 50, 52; *Webster v. Cooper,* 10 How., 54, 55; *Triplett v. Lowell,* 297 U. S. 638; *General Talking Pictures Corp. v. Western Electric Co.,* 305 U. S. 124.)

III.

SUMMARY OF ARGUMENT.

POINT A.

There is no diversity of decision between the courts below upon the question of whether presence of invention should be determined "objectively."

POINT B.

The finding of the Sixth Circuit Court of Appeals that the question of invention be determined and gauged by what is obvious or unobvious in the rubber manufacturers' art was based upon evidence that patentees in the rubber heel art resorted to the use of the skill of rubber manufacturers to produce their heels. This does not constitute use of the "subjective" test, and this whole question is immaterial to the issue herein asserted by petitioner.

POINT C.

The Sixth Circuit Court of Appeals in denial of the Motion For New Trial (Record page 511) concurred with the District Court's ruling (Record page 57) in excluding, at the instance of respondent, evidence as to the alleged difficulties involved in the method or process by which such heels are manufactured, which evidence was excluded on the well-established rule that a patentee is estopped by

proceedings in the Patent Office from recapturing a position once relinquished. There is no diversity of opinion in this case or in the Federal Courts generally on the "File Wrapper Estoppel," and this question is immaterial to the present petition.

POINT D.

It is immaterial that there is diversity of decision between the various courts of appeals concerning the character of the test of invention used, or of the standard of invention which this Court has established, because, upon the objective test asserted in behalf of petitioner as the correct one (Petitioner's Brief page 20), the Sixth Circuit Court of Appeals found against petitioner.

IV.

ARGUMENT.

POINT A.

In order there shall be a clear understanding of the National Patent Planning Commission's recommendation that "patentability shall be determined objectively by the nature of the contribution in the advancement of the art and not subjectively by the nature of the process by which the invention may have been accomplished" reference is made to the general discussion under the subject of "Invention" in Chapter III, *Walker on Patents, Deller's Edition*, Vol. I, page 109, and particularly to the following excerpts:

Pages 118 and 119:

> *"No absolute rule by which to determine presence or absence of invention.*
>
> "In delivering an opinion of the Supreme Court, *in January, 1885,* Justice Matthews used some language which may be thought to establish an affirmative rule by which to determine the presence or absence of invention in every case. Speaking of a simple device

which the court held not to be an invention, he said that it 'seems to us not to spring from that *intuitive faculty of the mind* put forth in search for new results or new methods, creating what had not before existed, or bringing to light what lay hidden from vision; but, on the other hand, to be the suggestion of that common experience which arose spontaneously, and by a necessity of human reasoning, in the minds of those who became acquainted with the circumstances with which they had to deal.' (*Hollister v. Benedict Mfg. Co.*, 113 U. S. 59, 72, 28 L. Ed. 901, 905 (1885). See also, *Ford Motor Co. v. Parks & Bohne*, 21 F. (2d) 943, 949, C. C. A. 8 (1927); *Donner v. Sheer Pharmacal Corp.*, 64 F. (2d) 217, 221, C. C. A. 8 (1933), cert. den. 290 U. S. 658, 78 L. Ed. 570 (1933); *Saranac Mach. Co. v. Wirebound Pat. Co.*, 282 U. S. 704, 713, 75 L. Ed. 634, 630 (1930).) This language may be thought to mean that whatever new and useful process, machine, manufacture, composition of matter, or design is *produced by intuition* is an invention, and that whatever such thing is produced by reason is not an invention. But such an interpretation of the language would not be right. Intuition may sometimes reach to a single brilliant result; but intuition can never conceive or correlate the mazes of movements and mechanisms which constitute a modern automatic machine. To enforce such a rule as that hypothetically implied in the language of Justice Matthews would be to deny invention to those marvelous combinations of numerous metallic devices which constitute American automatic machinery, and which work with such complexity and yet with such precision that they seem themselves to be endowed with reason. *But fortunately the supposed interpretation of that language is evidently not the meaning of the court.* The court does not deny invention to all the products of pure reason in the useful arts. It merely finds want of invention in those things which are conceived 'spontaneously and by a necessity of human reasoning' in the minds of those who have their attention directed to the subject.

"In a later case the Supreme Court, speaking by Justice Brown of the meaning of the word 'invention'

said: 'The truth is, the word cannot be defined in such manner as to afford any substantial aid in determining whether a particular device involves an exercise of the inventive faculty or not. In a given case we may be able to say that there is present invention of a very high order. In another, we can see that there is lacking *that impalpable something* which distinguishes invention from simple mechanical skill. Courts, adopting fixed principles as a guide, have by a process of exclusion determined that certain variations in old devices do or do not involve invention; but *whether the variation relied upon in a particular case is anything more than ordinary mechanical skill is a question which cannot be answered by applying the test of any general definition.' (McClain v. Ortmayer,* 141 U. S. 419, 427, 35 L. Ed. 800, 803 (1891); and also see *City of St. Louis v. Prendergast,* 29 Fed. (2d) 188, 192, C. C. A. 8 (1928).)"

Pages 135 and 136:

"*Determination of invention, after applying objective tests, matter of subjective opinion.*

"In *Kirsch Mfg. Co. v. Gould Mersereau Co., Inc.,* 6 F. (2d) 793, 794, C. C. A. 2 (1925), Judge Hand gave an interesting summary on 'invention' in which he said:

" 'Objective tests may be of value vaguely to give us a sense of direction, but the final destination can be only loosely indicated. An invention is *a new display of ingenuity beyond the compass of the routineer,* and in the end that is all that can be said about it. Courts cannot avoid the duty of divining as best they can what the day to day capacity of the ordinary artisan will produce. This they attempt by looking at the history of the art, the occasion for the invention, its success, its independent repetition at about the same time, and the state of the underlying art, which was a condition upon its appearance at all. Yet, when all is said, there will remain cases when we can only fall back upon such good sense as we may have, and in these we cannot help exposing the inventor to the hazard inherent in hypostatizing such modifications

in the existing arts as are within the limited imagination of the journeyman. *There comes a point when the question must be resolved by a subjective opinion as to what seems an easy step and what does not.* We must try to correct our standard by such objective references as we can, but in the end the judgment will appear, and no doubt be, to a large extent personal, and in that sense arbitrary.'

"Thus it has been settled that the ideal line which separates things invented from things otherwise produced can never be concisely defined; and that *there is no affirmative rule by which to determine the presence or absence of invention in every case*; and that such questions are to be determined by means of several negative rules which operate by a process of exclusion. Each of those rules applies to a large class of cases, and all of them are entirely authoritative and sufficiently clear. To formulate those rules, and to state their qualifications and exceptions, and to classify and cite the adjudged cases from which those rules, qualifications, and exceptions are deducible, is the scope of several sections which follow."

Petitioner, in its Brief, page 18, has itself shown that the established test for invention in the Sixth Circuit Court of Appeals is the objective one as used in *U. S. Gypsum v. Consolidated*, 130 F. (2d) 888 prior to the present case. And in a very recent case, decided since the present one, we find the Sixth Circuit Court of Appeals so stating (*Trabon Engineering Corp. v. Dirkes, et al.*, 58 U. S. P. Q. 97, 100):

"We are likewise aware of the deep concern felt by patent lawyers and research engineers not only over higher standards of invention, but over what in some quarters has been thought to be *an entirely new concept of invention* deriving from *Cuno Corp. v. Automatic Devices Corp.*, 314 U. S. 84, 91 (51 USPQ 272, 275), where it was said that a new device 'however useful it may be, must reveal the flash of creative genius, not merely the skill of the calling.' *We do not interpret the observation as indicating anything*

more significant than that the quality of invention is 'something more' than expected mechanical skill. Nor do we read the phrase as another conscious effort to define the indefinable.

"*Long experience with assailed inventions in trial and on review, led us in humility to the conclusion that the inventive concept is an abstraction impossible to define,* and so for that reason courts have sought for simple rules by which its presence may be detected, and while these have proved helpful they are never absolute; *that long recognition of an existing problem in any art, and the advantages to accrue to an industry from its solution, have been considered as highly persuasive of invention when success is finally achieved;* that sometimes achievement is revolutionary, but more often an inventor begins where others have left off, and *perceives the vital forward step to which predecessors have been blind. Cleveland Trust Co. v. Schriber-Schroth Co.,* 92 F. (2d) 330-334 (35 USPQ 475, 477-480). Somewhat similar commentary was indulged in in *A. O. Smith Construction Co. v. Petroleum Iron Works,* 73 F. (2d) 531 (24 USPQ 183), at an earlier date. We have yet to encounter an invention which, prior art considered, seems to have sprung fully matured from the brow of genius. Whether in the great inventions adjudged patentable in the past the inventive concept arrived with the blinding suddenness of the lightning's flash, or from 'the projection of the imagination into the realms of the unknown,' or whether they were the product of painful and laborious experimentation apparently condemned as indicia of invention in *Picard v. Aircraft Corp.,* 128 F. (2d) 532 (53 USPQ 563) (CCA 2), we do not know. Some were undoubtedly the product of accidental discovery. At least so thinks Dr. Kettering, Chairman of the National Patents Planning Commission. Certain it is that Edison placed little confidence in inspiration when he defined genius as '2% inspiration and 98% perspiration.' *Of course, routine experimentation leading to a reasonably expectable result is not invention.* Conversely the most brilliant and inspired conception is not invention unless it can be reduced to

practice by novel means or method so that its utility may be demonstrated, *Reo Motor Car Co. v. Gear Grinding Machine Co.*, 42 F. (2d) 965, 968 (6 USPQ 9, 12) (CCA 6). All we can say in respect to the present problem is that *measured by the conventional tests by which the presence or absence of invention has been determined*, we are of the view that Hillis achieved a result *beyond the reach of routine skill in the art*, and that the claims in suit denote invention."

Thus, it appears there has been no deviation by the Sixth Circuit Court of Appeals from its long established use of objective test for invention.

Examining now the opinion here in question, we find that the Sixth Circuit Court of Appeals did not in this case deviate from its usual process. Referring to the opinion (Record page 486 *et seq.*) the Court in reaching its conclusion on the question, sought:

"* * * to ascertain *just what it was that Ingwer did that had not, in essence, been done before, and whether it denoted invention or was within expected routine skill of those laboring in the art.* The concavo-convex form of rubber heel was, of course, not the invention of Ingwer, nor does he claim it to be. In *I. T. S. Co. v. Essex Co.*, 272 U. S. 429, 434, it is pointed out that it is a characteristic of the concavo-convex type of rubber heel, because of the tendency of rubber to resume its original curved form to keep tightly pressed against the heel,—a characteristic called the 'tight edge effect'—and that it was referred to as early as 1889 in Ferguson's patent No. 638,228. The Tufford heel, reissue patent No. 14,049, owned by the present appellee and by it litigated in the Essex case and elsewhere, is of the concavo-convex type. Its merit in sealing the joint between lift and heel was widely proclaimed. It was old to insert an inextensible plate of metal, leather, or fabric, between the rubber lift and the wooden heel, as shown by the patents of Warren No. 1,564,158, No. 1,681,961, and Ross No. 1,604,659. The examiner pointed out that there was no patentable distinction between molding and vul-

canizing fabric to a portion of the concave surface of a rubber heel, and covering its entire surface by such molding and vulcanizing, especially as Roberts shows the application of a plate to the entire area of heel surface. No inventive concept resides in the mere thought of a unitary construction of rubber and fabric. This was disclosed in Lucier No. 1,439,-564, December 19, 1922, and Feinstein in his patent, also discloses such unitary construction.

"Feinstein's heel lift is flat, but it may not be claimed, and perhaps is not, that to give the Feinstein heel the well-known conventional concavo-convex shape, denoted an inventive concept. *What then, was Ingwer's contribution to the art?* The appellee says that forcing the edge of the rubber lift always against the edge of the heel with enough pressure to seal the seam, maintaining this situation during the flexing and unflexing of the heel in response to the tread of the walker, and at the same time limiting this action so that it would not dislodge the edges of the fabric, required a very careful reconciling of antagonisms to provide a kind of automatic force in the lift that would maintain the seam sealed under these conditions and not force the fabric out beyond the edge of the heel; that this was accomplished by a molding and vulcanizing which resulted in a bond between two heterogeneous materials without disruption of either or of the joint. But Feinstein also bonded the two heterogeneous materials. His use of the term 'vulcanizing' may be ambiguous in view of the practical construction that he and his licensee, the Day Wood Heel Company, put upon the patent, for they united the rubber and fiber by rubber cement. While this is sometimes referred to as a 'vulcanizing cement' and the operation as 'vulcanizing,' it is undoubtedly not as good a bond as vulcanizing and molding.

"But whatever may have been Feinstein's practice, it is clear that his patent teaches a unitary combination of rubber and fiber. Granted that Feinstein's bond between the two materials is less permanent than Ingwer's, because of the tendency of flexing to disintegrate the cement and so loosen the bond, the vulcanization of

fiber and rubber was the invention neither of Feinstein nor Ingwer. *Besides the suggestions in this specialized art itself*, it must have been perfectly obvious to those working in rubber, that fiber and rubber could be successfully bonded by vulcanization. The *practices of the great tire companies in uniting webbed fabric and later cord fabric to rubber by vulcanization, which permitted utilization both of rubber resilience and the restraint of fibrous material* (*Firestone Tire & Rubber Co. v. U. S. Rubber Co.*, 79 Fed. (2d) 948), must be adjudged as within the knowledge of the art with which we are dealing. The multiple plies were widely advertised. It is idle to urge that the automobile tire is in a non-analogous art. *When inventors of rubber heel lifts sought to exploit their patents they turned naturally to the tire companies for manufacture of their devices, Nerger to U. S. Rubber Co., Tufford to Miller, Feinstein or its licensee, to Firestone.* The essence of the Ingwer concept, therefore, does not reside in the use of the concavo-convex form, the insertion of non-extensible fabric between lift and heel, or in joining rubber and fabric into a unitary construction. All these things had been done. *We understand, of course, that these are combination claims and that a valid patent may issue for a new combination even though all its elements be old. But this is true only where the quality of invention is exercised in the combining to bring about a new mode of operation and produce a new and useful result.* Ingwer improved upon Feinstein *by utilizing the well understood method of vulcanization to create a better bond* between the two elements of his patented combination. Such improvement was advance only in *degree*, and as such must yield to the rule, *that a mere carrying forward of a new or more extended application of the original thought, a change only in form, proportions, or degree, the substitution of equivalents doing the same thing in the same way by substantially the same means with better results, is not such invention as will sustain a patent. Smith v. Nichols*, 21 Wall. 112, 119; *Glue Co. v. Upton*, 97 U. S. 3; *Dunbar v. Myers*, 94 U. S. 187, 199; *Railroad Supply Co. v. Elyria Iron Co.*, 244 U. S.

285, and in our own court *Ford Motor Co. v. Ohio Stamping & Engineering Co.*, 56 Fed. (2d) 807, 808; *Blackmore v. Ford Motor Co.*, 56 Fed. (2d) 806.

"Nor is there wanting in the history of the art, as disclosed by the record, facts that compel conclusion that the inventor but substituted new materials for old in a conventional combination. While such substitution may have resulted in a superior article it was not necessarily a patentable invention. *Florsheim v. Schilling*, 137 U. S. 64, 76; *Kemper-Thomas Co. v. J. P. Gordon*, 67 Fed. (2d) 478 (C. C. A. 6); *Firestone Tire & Rubber Co. v. U. S. Rubber Co., supra. Much was made of the commercial success of the Ingwer heel lift and undoubtedly it made a deep impression upon the court below, but the appellee was already a highly successful manufacturer of rubber reels with an established goodwill throughout the country.* Its phenomenal growth, based upon the Tufford heel, is fully disclosed in the opinion of the late Judge Westenhaver, adopted by this Court in *Fetzer & Spies Leather Co. v. I. T. S. Rubber Co.*, 260 Fed. 939, wherein it is shown that without advertising or soliciting salesmen, its business grew from a production of a few thousand heels a month to over 2¼ million in three years, and with an initial capital of $30,000 in 1915, its undivided profits in 1918 were $800,000 after net earnings in the previous year of $482,000. *It is little wonder that the appellee, with an extensive advertising campaign, could readily market an improved heel, and its success is little tribute to the inventive character of the improvement. Standard Parts Inc. v. Toledo Pressed Steel*, 93 Fed. (2d) 336 (C. C. A. 6), aff., 350 U. S. 350. Likewise does this history obscure the picture sought to be drawn of the controversy as one between an enterprise of a poor but honest cobbler continued by two shoe-clerks after his death, and a powerful rubber company with highly developed selling and advertising talents. We are of the opinion that the claims in suit are invalid for want of invention."

Nothing could be clearer from the foregoing quotation than that the Sixth Circuit Court of Appeals used the ob-

jective test "by the nature of the contribution to the advancement of the art"; and at no point in its decision upon the question of invention did it base its opinion upon "the nature of the process by which the invention may have been accomplished." The opinion had nothing to say concerning inventive "intuition" or the "flash of genius." In fact, the Record in this case shows that respondents did not attempt to bring out in the record or to urge before the courts below that there was any "process by which the invention may have been accomplished" which indicated lack of invention. The respondents in both courts below relied upon well-established principles applied by this Court in cases such as *Atlantic Works v. Brady*, 107 U. S. 192, *Smith v. Nichols*, 21 Wall. 112, and *Gardner v. Herz*, 118 U. S. 180, which cases exemplify a finding of lack of invention by objective rather than subjective tests.

POINT B.

Petitioner's Brief, page 29, treats of the rubber manufacturers' art as being "alien" to the shoe-maker's art in respect to the production of rubber heels. Such is not the fact. As stated by the court below (Record page 488 *et seq.*):

> "It is idle to urge that the automobile tire is in a non-analogous art. *When inventors of rubber heel lifts sought to exploit their patents they turned naturally to the tire companies for manufacture of their devices,* Nerger to U. S. Rubber Co., Tufford to Miller, Feinstein or its licensee, to Firestone."

Moreover, it is a matter of common knowledge that rubber heels, as *used* by cobblers, are *manufactured* by rubber companies. These two arts may therefore not be divorced from each other as the District Court had considered proper. In reversing the District Court, the Sixth Circuit Court of Appeals considered that designers of rubber heel lifts would naturally turn to tire and rubber

companies as it was proved Feinstein and Day Wood Heel Company both did in the instant case. This is not testing an alleged invention "by the nature of the process by which the invention may have been accomplished." This whole question of analogy of the arts is objective and therefore immaterial on the principal question asserted by petitioner.

POINT C.

It is well settled by the decisions of this and lesser Federal Courts (See *Keystone Co. v. Northwest Eng. Co.*, 294 U. S. 42 and *Valjean et al. v. Perfection Stove Co.*, 103 F. (2d) 60) that a patentee may not in an infringement suit recapture a position which he relinquished in the proceedings by which the patent was obtained. The patentee, Ingwer, having conceded that the method of molding and vulcanizing composite articles of rubber and fiber is old, by the cancellation of his method claims (Record, page 252), could not in this suit be permitted to offer proof showing that this method of making composite heels is new, in support of the article or product claims which he retained. Obviously, the product claims, upon these facts, should be interpreted, as was done by both courts below, as purportedly covering a heel of certain composition and shape *as made by a concededly old method.*

Thus, there was not the slightest diversity of opinion between the District Court and the Sixth Circuit Court of Appeals on this point. The District Court sustained respondent's objection and the Court of Appeals denied petitioner's Motion for New Trial (Record page 511) which was based upon the alleged error of the District Court in excluding the evidence.

This matter of estoppel is entirely alien to the question raised by the present petition. There is no diversity of opinion throughout the entire Federal Judiciary upon the question of "File Wrapper" estoppel. As stated by

Walker on Patents, Deller's Edition, Vol. II, Sec. 249, page 1215, upon the authority of many cases:

> "Where an applicant, on the rejection of his application inserted in consequence of that rejection, limitations and restrictions into his specification, for the purpose of obtaining his patent, he cannot, after he has obtained it, claim that it shall be construed as it would have been if such limitations and restrictions were not contained in it. (Citing cases.)"

Here again the situation existing in the present case would not be resolved by decision of this Court upon the issue of the "objective test" versus the "subjective test."

POINT D.

The approach of the Sixth Circuit Court of Appeals to the question of invention was "objective" rather than "subjective." It found the petitioner had failed, by satisfactory evidence, to meet the defense of lack of invention; had failed to establish that the patentee had "taken a step, not obvious and apparent" in the production of a composite heel like Feinstein's but of the concavo-convex shape; that the concavo-convex heel was old and well-known when the Feinstein heel was produced; and that Ingwer used as the process for producing that heel one, concededly old and well-known, for securing rubber and fiber together in a unitary structure by molding and vulcanizing.

The court below was not impressed by the contentions of the petitioner respecting the "existence of a demand unsupplied" or the proof of "prior effort and failure" which, considering the almost precise anticipation by each of Feinstein and Lucier, both of whom had carried out successful commercial operations, was of a very flimsy nature.*

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* The Feinstein heel was on the market when this case was tried, and presumably still is.

Nor was the court convinced that the favorable public reception of the Ingwer heel when put on the market and the commercial success thereof were due to the presence of invention. The court found upon the evidence that the commercial success was due to other causes.

Petitioner cannot complain. The Court below used petitioner's own test of invention, and found none.

V.

CONCLUSION.

The opinion of the Sixth Circuit Court of Appeals in *U. S. Gypsum v. Consolidated, supra,* cited on pages 18 and 19 of petitioner's brief, establishes that *prior to the recommendation of the National Patent Planning Commission,* the Court of Appeals had rejected the subjective test for invention, "nothing is an invention which is * * * progress * * * through trial and error." The opinion of the Sixth Circuit Court of Appeals in *Trabon v. Dirkes et al., supra, rendered since the recommendation,* indicates that the Circuit Court of Appeals had long been in agreement with the National Patent Planning Commission recommendation respecting use of the objective test. The opinion, the review of which petitioner seeks in this Court, applied the objective test in the same way as was done by the same court, *both before and after the report of the Commission.* The Sixth Circuit Court of Appeals used the petitioner's own test. This, therefore, is not a proper case for determination of any issue raised by the petition.

Accordingly, respondents urge that the petition be denied for want of jurisdiction, as seeking the answer to an academic question bearing no relation to the facts of the case.

Respectfully submitted,

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